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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,148	06/02/2005	Francisco Javier Romero Amaya	38184.04013US	1705

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EXAMINER

ORWIG, KEVIN S

ART UNIT

PAPER NUMBER

1611

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12/15/2008

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,148

**Applicant(s)**

ROMERO AMAYA ET AL.

**Examiner**

Kevin S. Orwig

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5, 6, and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendments filed Sep. 18, 2008 were entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejections of claims 1, 2, and 21-26 under 35 U.S.C. 102 is withdrawn, in light of the claim amendments.

The rejections of claims 1, 2, 5, 6, and 21-26 under 35 U.S.C. 103 are maintained as discussed below. All references are of record in the prior Office action.

#### ***Claim Rejections - 35 USC § 103***

**Claims 1, 2, 5, 6, and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over BUSCHHAUS (WO 98/18328; May 7, 1998; 5<sup>th</sup> reference cited on IDS dated Jun. 2, 2005) (hereinafter Buschhaus) in view of ISATO (JP8039511; Feb. 2, 1996; 1<sup>st</sup> reference cited on IDS dated Jun. 2, 2005) (hereinafter Isato) and SUN (U.S. 2003/0194419; Jun. 9, 1998; of record) (hereinafter Sun).**

1. Buschhaus discloses insecticide and resin-containing glues and adhesives for plywood and timber materials (abstract; page 8, lines 7-18). These adhesives also contain other additives, such as flour (i.e. a spreadability additive) and fungicides (page 8, lines 15-18). Buschhaus does not explicitly disclose bifenthrin as an insecticide in their formulations, and are silent as to the particle size of the included insecticides.

2. Isato discloses bifenthrin-containing adhesives (i.e. glues) for use with, *inter alia*, wood, plywood, laminated wood and other wood products (abstract; paragraph [0004] of translation). The adhesives disclosed by Isato also contain additives including wheat flour (paragraph [0006] and example of translation). Since both Buschhaus and Isato are concerned with insecticide containing adhesive formulations for wood products, and since Isato disclose bifenthrin as a suitable insecticide in such a formulation, it would *prima facie* obvious to one of ordinary skill in the art at the time of the invention to substitute one known insecticide (i.e. bifenthrin) for another in the formulation of Buschhaus.

3. Sun discloses pesticidal matrices wherein the insecticides have a particle size of less than 10  $\mu\text{m}$  and a preferable particle size of 0.1-5  $\mu\text{m}$  (paragraph [0021]). Furthermore, as noted in paragraph 1 above, bifenthrin formulations having the specified particle size(s) are commercially available, and use of such a commercially available bifenthrin product would fulfill the particle size limitation of claim 1. Nonetheless, the teaching of Sun regarding particle size of insecticides in matrix formulations provides sufficient rationale for one skilled in the art to utilize bifenthrin of the specified particle size in the formulations of Buschhaus or Isato. Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin in the specified particle size(s) in the formulation of Buschhaus to achieve the desired insecticidal effects, reading on instant claims 1, 2, and 21-26.

4. Buschhaus also teaches the use of insecticide concentrations from 30-104 g ai/m<sup>3</sup> (examples 1-5). Thus, in conjunction with the discussion above, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin in the specified concentration range in the formulation of Buschhaus to achieve the desired insecticidal effects, reading on instant claim 5.

5. Buschhaus also teaches the use of phenol/formaldehyde resins as well as urea/resorcinol resins (page 8, lines 10-13). Thus, in conjunction with the discussion above (paragraphs 6-8), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin and one of the resins taught by Buschhaus *et al.* to prepare an adhesive with the desired insecticidal effects, reading on instant claims 6 and 24.

### ***Response to Arguments***

Applicants' arguments have been fully considered but are not persuasive. Applicants argue that Buschhaus does not contemplate, suggest, or teach the use of bifenthrin in their adhesive compositions. As stated in the prior Office action, bifenthrin is not explicitly taught by Buschhaus. However, Buschhaus exemplifies the pesticide-containing wood products of their invention by testing them against termites (page 10, lines 11-13; page 11, lines 7-9; page 13, bottom table). Thus, while Buschhaus does not explicitly teach the use of bifenthrin, such a use is suggested as would be recognized by one of ordinary skill in the art since bifenthrin was a well-known termiticide at the time of the invention (see evidentiary reference Smith *et al.*; title, abstract).

As set forth in the prior Office action, Isato clearly teaches the use of bifenthrin in wood adhesives (i.e. glues) for use with, *inter alia*, wood, plywood, laminated wood and other wood products (abstract; paragraph [0004] of translation). The adhesives disclosed by Isato also contain additives including wheat flour (paragraph [0006] and example of translation). Thus, Isato establishes that bifenthrin is a suitable termiticide for use in adhesive compositions such as those taught by Buschhaus. As discussed in the prior Office action, the MPEP states that simple substitution of one known element for another to obtain predictable results is a proper rationale that may support a conclusion of obviousness (see MPEP § 2141). In this case, the ordinary artisan would have had a high expectation of success of producing a termite-resistant wood adhesive in substituting bifenthrin for any of the insecticides taught by Buschhaus since Isato establishes that it is a suitable component in similar adhesive compositions.

Applicant argues that Sun teaches away from the claimed invention because of applicants' disclosure that the repellent effect of bifenthrin is significantly influenced by particle size. However, Sun provides the motivation for the ordinary artisan to use a pesticide having the claimed particle size in a composition. For example, Sun teaches that the disclosed pesticidal matrices improve the stability of the pesticide (paragraphs [0010] and [0011]). Thus, the ordinary artisan would be motivated to use the particulate matrix taught by Sun in the composition of Buschhaus in order to maintain the stability of the pesticides over a longer period of time. It is noted that the claim language uses the term "comprising", and does not exclude the inclusion of such a pesticide-containing matrix in the glue composition. As stated previously, Sun also teaches that the

insecticides used in the invention have a particle size less than 10  $\mu\text{m}$  and a preferable particle size of 0.1-5  $\mu\text{M}$  (paragraph [0021]). As noted by applicants, this particle size is prior to coating into the matrix taught by Sun. However, the final particle size of the coated matrices taught by Sun is preferably from 2-10  $\mu\text{m}$  (paragraph [0019]; claim 25). One of ordinary skill in the art would recognize this range to represent a mean particle size. Thus, it is obvious to utilize known and routinely used particle sizes of insecticides. Therefore, if an artisan wanted to produce a stable, anti-termite wood adhesive, one would have been motivated to substitute bifenthrin in the adhesives of Buschhaus as taught by Isato and to prepare the bifenthrin as a coated pesticidal matrix having a particle size of 2-10  $\mu\text{m}$  as taught by Sun. The artisan would find all the motivation necessary to produce the claimed invention in the prior art by the combination of Buschhaus, Isato, and Sun as discussed above. The disclosure of the instant application has no relevance to these motivations and the argument to this effect is moot.

It is noted that a reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary,

the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

### ***Summary/Conclusion***

Claims 1, 2, 5, 6, and 21-26 are rejected; claims 3-4 and 7-20 are cancelled.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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KSO

/Sharmila Gollamudi Landau/  
Supervisory Patent Examiner, Art Unit 1611